

**AMENDMENT**

**IN THE SPECIFICATION**

Please amend the specification as indicated in Appendix A submitted herewith according to 37 C.F.R. § 1.121 concerning a manner for making amendments to the specification.

**IN THE CLAIMS**

Please amend the claims as indicated in Appendix B submitted herewith according to 37 C.F.R. § 1.121 concerning a manner for making claim amendments.

**REMARKS**

Subsequent to the enclosed amendment, claims 1-2, 4-10, 17-18, 20-25 and 27-36 will be presently pending in the captioned application with claims. Claims 1, 8-9, 17, 23-25 and 31-32 are amended and claims 2, 4-7, 10, 18, 20-22, 27-30 and 33-36 are pending as originally filed. Claims 3, 11-16, 19 and 26 are canceled.

Claims 1, 17 and 25 have been amended to recite "magnesium hydroxide particles" in accordance with the Examiner's suggestion to overcome an indefiniteness rejection. Claims 1 and 17 have also

been amended to recite that F is a width of a secondary particle diameter ( $\mu\text{m}$ ) distribution of the magnesium particles. Support for the amendment can be found in claim 25.

Claims 8-9, 23-24 and 31-32 have been amended to recite that the metal content are "impurities" in response to the Examiner's request for clarity in the claims. Again, the amendments have been made in accordance with the Examiner's suggestions. Claims 23 and 32 have been amended for usage errors.

The specification has also been amended to recite the correct application Serial No. 09/622,002 and U.S. Patent No. 6,676,920. The paragraph on page 22, lines 14-22, has also been amended to reflect the term "II".

No new matter within the meaning of § 132 has been added by the amendment.

Accordingly, Applicants respectfully request the Examiner to enter the indicated amendments of Appendix A and Appendix B, withdraw the outstanding rejections in view of the arguments and amendments and allow all presently pending claims.

**1. Rejection of Claims 1-2, 4-10, 17-18, 20-25 and 27-36**  
**under 35 U.S.C. § 112, ¶ 1**

The Office Action rejects claims 1-2, 4-10, 17-18, 20-25 and

27-36 under 35 U.S.C. § 112, ¶ 1 as failing to comply with the enablement requirement. The Office Action states:

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not describe how the relationship as defined in equation (II) is obtained. Furthermore, it is not described how F is measured or determined. In addition, the term "F" as being used in the instant disclosure is confusing. "F" is initially termed as a "secondary particle diameter" that satisfies equation (II), yet at page 22, lines 13-22, the definition of "particle size distribution width" also appears to describe "F". Are "secondary particle diameter" as defined in equation (II) and "particle size distribution width" being used interchangeably in the instant specification or are they different? Clarification is required.

Applicants respectfully traverse the rejection because the specification provides an adequate description of how the relationship (II) as defined in claim 1 is obtained. However, claims 1 and 17 have been amended to recite that F is a width of a secondary particle diameter ( $\mu\text{m}$ ) distribution of the magnesium particles in conformance with claim 25.

Turning to the rule, the first paragraph of 35 U.S.C. § 112 requires that the "specification shall contain a written description of the invention . . .". To satisfy the requirement,

the specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1550, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). Moreover, a description as filed is presumed to be adequate, unless the examiner presents sufficient evidence or reasoning to rebut the presumption. See e.g., In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971).

The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description wherein the examiner has the initial burden of proving why a person skilled in the art would not recognize a description of the invention defined by the claims. See In re Wertheim, 541 F.2d at 263-64, 191 USPQ at 97; "Guidelines for the Examination of Patent Application Under the 35 U.S.C. 112, §1, "Written Description" Requirement" Federal Register, Vol. 66, No. 4, (Friday, January 5, 2001).

In the present application, the term F as claimed in claims 1 and 17 represents the particle size distribution width calculated from the following equation:

$$F (\%) = A_2 (\%) - A_1 (\%)$$

$A_1 (\%)$  represents an accumulated volume distribution at a

first stage where the particle size was determined on the basis of the particle size distribution measured according to the method provided in subsection (1) on page 21, line 4-19 of the specification. The accumulated volume distribution  $A_1$  (%) was determined by multiplying the average secondary particles diameter with 0.3.

$A_2$  (%) represents an accumulated volume distribution at a second stage where the particle size was determined on the basis of the particle size distribution also measured according to the method provided in subsection (1) on page 21, line 4-19 of the specification. The accumulated volume distribution  $A_2$  (%) was determined by multiplying the average secondary particles diameter with 1.7.

The difference of  $A_1$  and  $A_2$  were then taken to arrive at the average particle size distribution width  $F$  as shown in the above equation.

The specification clearly provides in sufficient detail the necessary teachings such that one skilled in the art could reasonably conclude that the inventors of the present invention had possession of the claimed invention.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the written description rejection in view of the amendment to claims 1 and 17 and the submitted arguments.

**2. Rejection of Claims 1-2, 4-10, 17-18, 20-25 and 27-36**  
**under 35 U.S.C. § 112, ¶ 2**

The Office Action rejects claims 1-2, 4-10, 17-18, 20-25 and 27-36 under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states:

In claim 1, lines 6, 8 and 12 "all of the particles" is confusing and lacks proper antecedent basis. Does "the particles" mean "magnesium hydroxide particles"? If so, "magnesium hydroxide" must be inserted before "particles". Last line, "magnesium particles" has no clear antecedent basis.

Claims 8 and 9 are confusing in that it's unclear how the metal content is related to the magnesium hydroxide particles. They appear to be impurities in the magnesium hydroxide particles. And thus must be recited accordingly for clarity.

Claims 17 and 25 suffer the same deficiency of claim 1.

Claims 23, 24, 31 and 32 suffer the same deficiency of claims 8 and 9.

Other claims are deemed indefinite in view of their dependency upon claim 1, 17 or 25.

Applicants respectfully traverse the rejection. However, in the interest of advancing prosecution, Applicants have followed the Examiner's suggestions for overcoming the indefiniteness rejections. It is noted that the claim amendments are only

intended to overcome the indefiniteness rejections and in no way change the scope of the invention.

In particular, claims 1, 17 and 25 have been amended to recite "magnesium hydroxide particles" in accordance with the Examiner's suggestion. Claims 1 and 17 have also been amended to recite that F is a width of a secondary particle diameter ( $\mu\text{m}$ ) distribution of the magnesium particles.

Claims 8-9, 23-24 and 31-32 have been amended to recite that the metal content are "impurities" in response to the Examiner's request for clarity. Again, the amendments have been made in accordance with the Examiner's suggestions.

Accordingly, Applicants respectfully submit that the presently claimed invention is definite and respectfully request reconsideration and withdrawal of the rejections.

#### **CONCLUSION**

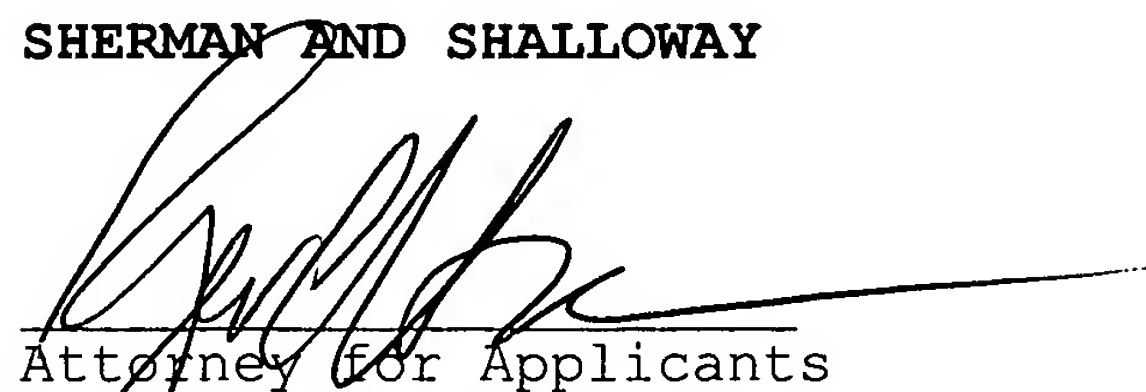
In light of the foregoing, Applicants submit that the application is now in condition for allowance. The Examiner is therefore respectfully requested to reconsider and withdraw the rejection of the pending claims and allow the pending claims. Favorable action with an early allowance of the claims pending is

earnestly solicited.

Respectfully submitted,

**SHERMAN AND SHALLOWAY**

**SHERMAN AND SHALLOWAY**  
413 N. Washington Street  
Alexandria, Virginia 22314  
703-549-2282

  
\_\_\_\_\_  
Attorney for Applicants  
Roger C. Hahn  
Reg. No. 46,376